

examiner in December 2001 and has interpreted group I to include claims 1-15 and 23-35. If applicant's present interpretation is incorrect, the examiner is requested to telephone applicant's counsel to clarify the matter further. The examiner indicated that Group II contains claims 16-22, drawn to a network resource allocation classified in class 709, subclass 226. However, independent claim 16 of group II is drawn to a method of selecting a server to fill a client request for content. This claim is believed to be closely related to claim 1 which relates to a method of loading content to a server in anticipation of a need for content by network clients. In each case a first and second proximity is determined between a client and a server. Therefore, applicant respectfully submits that claims 16-22 should be examined with the claims of group I.

The examiner indicates as a basis for the restriction requirement that inventions I and II are related as subcombinations disclosed as useable together in a single combination. The examiner further states that the subcombinations are distinct from each other if they are shown to be separately useable. The examiner specifically indicates that invention II has separate utility such as routing users' requests to a server resources based on proximity of servers with respect to client computers.

Even if the claims are drawn to patentably distinct or independent inventions, MPEP § 803 provides that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." Although the scope of the claims of group I and group II varies and applicant agrees that the claims are patentably distinct, many of the claimed features are similar. For example, each of the claims of group I in claims 1-15 and group II requires determining a first proximity between one or more clients and a first server and a second proximity between one or more clients and a second server. Accordingly, although it is acknowledged that the inventions of groups I and II are patentably distinct, applicant respectfully submits that it would not unduly burden the examiner to simultaneously examine the claims of groups I and II.

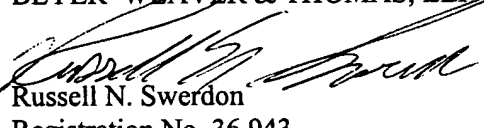
Moreover, prosecution had commenced in this matter long before the restriction requirement was issued. The first office action was mailed on July 9, 2001 and an amendment in response filed on October 9, 2001. MPEP section 811 directs that the examiner should make the restriction requirement "as early as possible in the prosecution." MPEP 811 goes on to state that if the requirement is not made in the first action, it should be made "as soon as the need for a proper requirement develops." Although applicant amended claims 16, 23, and 29 in response to

the first office action, none of the amendments present changed circumstances which would warrant imposing a restriction requirement at that point. In fact, the amendments to claims 16, 23, and 29 further defined proximity in each of the amended claims and thereby created additional similar elements between the claims of Group I and Group II, for at least the reason that claim 16 is part of Group II and claims 23 and 29 are part of Group I.

MPEP 811 also states that "before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if the restriction is not required." Applicant submits that no serious burden will result if the restriction is not required. The entire claimed invention has already been searched in preparation of the first office action. The different claim groups identified in the new restriction requirement are sufficiently close that an updated search can be conducted of all claims without significant burden. Evidence of the closeness of the claim groups may be gleaned from the results of the first search by the examiner. In the first office action, Shah (US Application Ser. No. 09/175,516) was identified as a prior art reference in rejecting claims from *both* Group I and Group II. Thus, it would appear that at least as of the time of the first office action that the examiner did not believe it to be a significant burden to search the claims of Group I and Group II.

Conclusion

Therefore, for the substantive and procedural reasons identified above, applicant respectfully submits that the claims of Group II (i.e., claims 16-22) should be examined with the claims of Group I. If the examiner believes that a telephone conference would expedite the prosecution of this application, he is invited to contact the applicant's undersigned attorney at the telephone number set out below.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP

Russell N. Swerdon
Registration No. 36,943

P.O. Box 778
Berkeley, CA 94704-0778
(510) 843-6200